



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,930	09/29/2003	Josef Dietl	24307-009001/2002P00240US	2375

32864 7590 12/26/2008
FISH & RICHARDSON, P.C.
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

HOMAYOUNMEHR, FARID

ART UNIT	PAPER NUMBER
----------	--------------

2439

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

12/26/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/675,930	Applicant(s) DIETL, JOSEF	
	Examiner Farid Homayounmehr	Art Unit 2439	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 November 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,3-8,10,11 and 13-17.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Kambiz Zand/
Supervisory Patent Examiner, Art Unit 2434

Continuation of 11. does NOT place the application in condition for allowance because:

The amendments to claims 1, 10 and 11 are not entered as they change the scope of the claims. Applicant's arguments relative to existing claims is not persuasive as described in the following.

Applicant argues that Shioda teaches away from a document in a human-readable form because Shioda's intention is to maintain security by making the data sheet in a form not recognizable by a human. However, Shioda's embodiment for a data sheet that is not recognizable by a human is not teaching away from an embodiment that includes a data sheet recognizable by a human. Shioda is related to information security, and teaches an embodiment that makes the data unrecognizable by unauthorized users. Shioda and other arts related to information security propose such embodiment to protect data from being stolen. There is nothing in Shioda that requires data being permanently or unconditionally presented in a form that is not recognizable by a human. When the user is authorized the encoded data (data in a form unrecognizable to human) is decoded and presented to the authorized user. In fact, Shioda figure 12 shows that the encoded document is decoded (human recognizable) and printed.

Regarding the teaching of elements of the claimed invention, Applicant first argues that Slater does not teach approval codes and approval marks. However, Slater paragraph 30 teaches signing of the document by users. When the document is printed, the signatures are printed, and therefore an approval mark is printed.

Applicant's second argument is that Slater does not explicitly teach generation of an encrypted digital signature. However, the cited portion of Slater shows that the digital signature is decrypted. This shows that the signatures must have been encrypted at some point, and therefore clearly suggesting to the one skilled in art to generate an encrypted digital signature. Applicant further argues that the encrypted digital signatures are not control codes, without pointing out a single property of a control code that could potentially distinguish it from the encrypted digital signature.

Applicant further argues that Slater does not teach a second control code. However, as stated in page 8 of the Final Action, Slater teaches signing the whole document (which already includes other digital signatures and hence control codes) to generate a secondary digital signature. The rejection readily shows an embodiment of wherein the document is converted to canonical form before being signed. Applicant argues that the signature of the notary applies to the document irrespective of form of the document. It is not clear how this traverses the rejection. Even if it were true, the digital signature of the document would be applied irrespective of the document being in the canonical form. Therefore, a digital signature is generated from a document in the canonical form. Applicant further argues that the signature is not generated from the content, rather, the signature is the content. To support this argument applicant points to Slater paragraph 13 which says the digital signatures are embedded in the document and cannot be disassociated with the document. However, first the digital signatures are created from the content and then embedded with the content. Therefore, the content is evolved to include all the signatures in embedded in it. Each digital signature is created from the content at a particular stage (see Slater Figures 2 and 3 and associated text). Second, if the digital signature is embedded in the content, it would be part of the content and not considered to be the entire content. Therefore the digital signature is not the whole content.

Applicant further argues that nothing in Slater or Shioda teaches a print out of the first and second control codes. However, as discussed above and in the rejection of claim 1, Slater teaches a document including first and second digital signatures, embedded in the document. At least Slater paragraphs 64 and 84 suggest generation of a printout of the entire document (which includes the first and second control codes). Therefore, the rejection shows a printout of the document including the first and second control codes. Slater paragraph 31 to 34 shows verification of all digital signatures. As indicated above and in the rejection, there are at least two sets of digital signatures, each of which verified as shown in Slater paragraph 31-34. Therefore, Slater teaches verification of the first and second control codes.

Based on the discussion above, applicant's argument regarding allowability of the pending claims is non-persuasive.